

REMARKS

This is a response to the new Final Office Action which is issued to reopen prosecution in response to the Appeal Brief filed on July 24, 2006, and reinstate previously withdrawn grounds of rejection, i.e., the rejection of claims 18-20, 22 and 25-28 under 35 USC. 101, which rejections were withdrawn in view of Applicants previous Amendment filed on April 20, 2005, well over a year ago.

In view of the fact that the new Final Action merely reiterates previous claim rejection and fails to respond to the Applicants' arguments against the rejections and in favor of patentability as set forth in the Appeal Brief, Applicants maintain the claims rejections set forth in the new Final Action are invalid for those reasons set forth in the Appeal Brief, which is incorporated herein by reference.

As for the reinstatement of the previously withdrawn rejection of claims 18-20, 22 and 25-28, Applicants once again request reconsideration and withdrawal of these rejections so as to reduce the issues on Appeal. It should be noted that Applicants will hereby reserve their right to reinstate the Appeal process, and will indeed reinstate the Appeal process hereafter given that the same claim rejections are maintained.

Reinstatement of Previously Withdrawn Claim Rejections under 101

With regard to the 101 rejection of claims 18-20, 22 and 25-28, it is bewildering that the Examiner would maintain that *a program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine* to perform the method steps recited in claim 18 is a nothing more than a method directed "solely to an abstract idea". In particular, when addressing claims 18-20, 22, 25-28, the Examiner fails to consider that the claimed inventions are directed to *a program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform method steps for*

characterizing device mismatch in a semiconductor integrated circuit. In this regard, the Examiner's analysis and findings are not on point as the claimed inventions are directed NOT to a process, per se, but rather a device- a program storage device having instructions for performing the claimed process steps.

As explained in MPEP 2106(IV)(B)(1), descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Here, at the very least, claim 18 should be properly viewed as being directed to program storage devices having functional description material recorded thereon, and is thus, directed to statutory subject matter. The Examiner's rejection fail to acknowledge or even consider this.

In view of the above, it is requested that the rejection of claims 18-20, 22 and 25-28 be withdrawn, so as to minimize the issues on appeal and not unnecessarily burden the Board with seemingly invalid rejections.

Appeal Brief Objection


It should be noted that Applicants respectfully disagree with the Examiner's objection to the Summary of Claimed Subject Matter as set forth in the Appeal brief. The Examiner objects to the fact that the same or similar pages and line numbers are used to support a concise explanation of the subject matter of claims 1, 18 and 35. In general, this objection appears to be based on the Examiner's mistaken belief that a series of independent claims of similar scope but covering different embodiments could not be supported by citation to the same page number and

lines. However, in the case at bar, claim 1 recites method steps directed to a process, claim 18 is directed to a program storage device with instructions to perform method steps recited in claim 1, and claim 35 is directed to a system having constituent components that implement functionality or processed the same or similar to the process steps recited in claim 1. Therefore, citation to the same or similar portions of Applicants' specification to support the subject matter of claims 1, 18 and 35 is undoubtedly proper, and not legally defective, per se.

However, in the interest of cooperation, Applicants will address the "program storage device" limitation of claim 18 with reference to the subject matter on page 6, line 2, through page 7, line 6. Moreover, with regard to the system claim 35, the Examiner should note that the "system" and "program analyzer" limitations are indeed referenced in the Appeal brief by page 9, lines 6-16 and FIG. 1, blocks 102, 103 (see page 7 of the Appeal brief), but Applicants will be sure to make any necessary clarifications in the next Appeal brief in this regard.

If the Examiner truly believes that there are other valid issues that should be raised with regard to rejections, or supposed "defects" in the Appeal, Applicants request that the Examiner raise such issues in the next response. It should be noted that Applicants object to the Examiner's failure to proceed with the current appeal and reopening of prosecution on seemingly improper grounds. If the Examiner truly believes that the rejections set forth in the Final Action are valid and defensible in view of Applicants' arguments, it is requested that the Examiner proceed with the Appeal process in good faith and respond to Applicants' arguments without further delay.

Respectfully submitted,


Frank V. DeRosa
Reg. No. 43,584

F. Chau & Associates, LLC
130 Woodbury Road
Woodbury, New York 11797
TEL.: (516) 692-8888
FAX: (516) 692-8889